

REMARKS

1. The Amendments, the Support Therefor, and Basis for Entry

Three claims (13, 16, and 26) have been canceled, two new claims (30 and 31) have been added, and claims 11, 19, 21, 25, and 27 have been amended to leave claims 11, 12, 14, 15, 17-25, and 27-31 in the application. No new matter has been added by the amendments or new claims, wherein:

- **Claim 11** is amended to clarify the adjacent nature of the facing surfaces, i.e., that they're directly adjacent (as in FIG. 2, wherein the facing surfaces of the inner sheet 5 and the outer sheet 6 are directly adjacent each other), and also to recite that the bladder 3 (as in FIG. 2) is joined to outer sheet 6 and not inner sheet 5.
- **Claims 21 and 27** find support in (for example) page 2 lines 31-33 and page 3 line 32-page 3 line 7.
- **Claim 25** finds support in (for example) FIG. 2 (note inner sheet directly adjacent outer sheet 6 with bladder 3 being therebetween, and bladder 3 joined to outer sheet 6 and not inner sheet 5).
- **Claims 30-31** find support in (for example) FIG. 2 (note that outer sheet 6 is joined to bladder 3 at locations spaced away from where outer sheet 6 is joined to inner sheet 5).

2. Sections 2-3 of the Office Action: Rejection of Claims 11-24 under 35 USC §112(2)

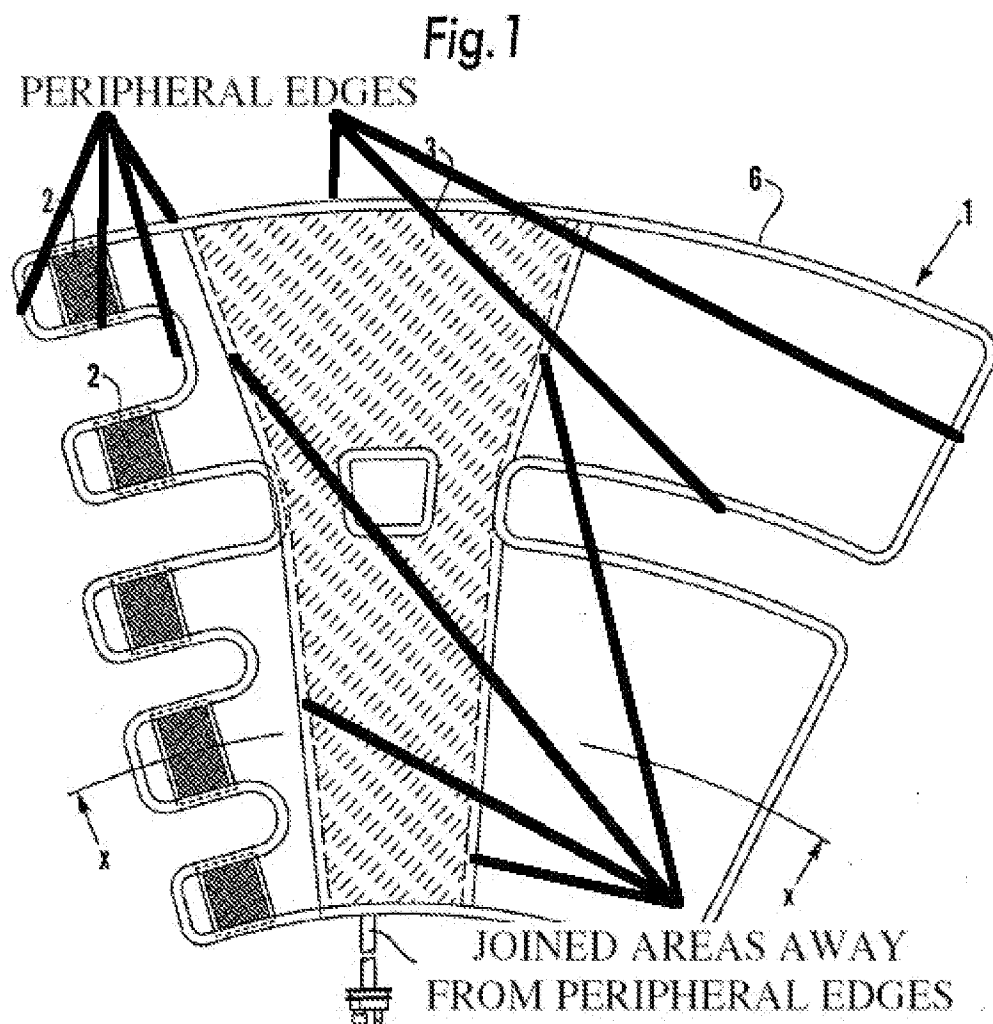
Kindly reconsider and withdraw these rejections. Since an ordinary artisan would comprehend the bounds of the claims when read in light of the specification, the claims are in compliance with 35 USC §112(2). As noted by the Court of Appeals for the Federal Circuit in *Miles Laboratories Inc. v. Shandon Inc.*, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993):

The "distinctly claiming" requirement [of 35 USC §112(2)] means that the claims must have a clear and definite meaning when construed in the light of the complete patent document. ... Section 112 thus ensures definiteness of claim language. ... The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. ... If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more.

(Citations omitted.) Or, as simply stated by MPEP 2173.02, the claims must "provid[e] clear warning to others as to what constitutes infringement of the patent." Further, as noted in the foregoing quote, a claim must be read in light of its specification to determine whether it is definite. See also *Howmedica Osteonics Corp. v. Tranquil Prospects Ltd.*, 74 USPQ2d 1680, 1683 (Fed. Cir.

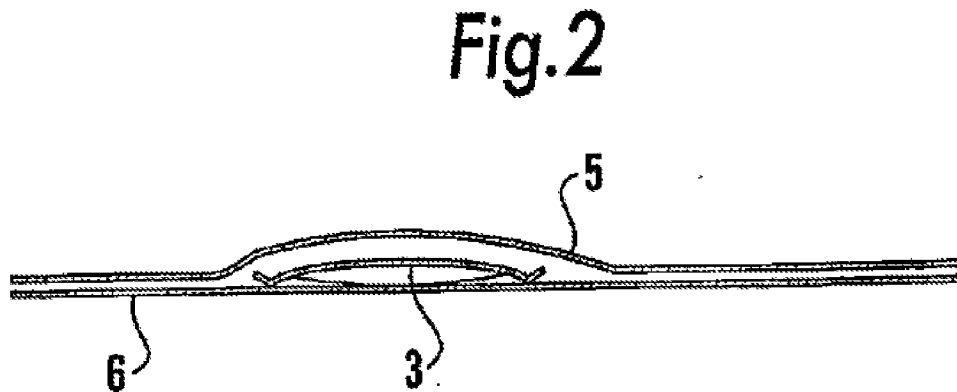
2005) (“[t]he definiteness of a patent claim depends on whether one skilled in the art would understand the bounds of the claim when read in light of the specification”); MPEP 2173.02 (“Definiteness of claim language must be analyzed, not in a vacuum, but in light of . . . [t]he content of the particular application disclosure . . .”). The claims in issue here are is clear and definite, both when read in a vacuum and even more so when read in light of the specification.

Claim 11 recites that “the inner and outer sheet include adjacent facing surfaces bounded by peripheral edges, the facing surfaces having joined areas extending at least about their peripheral edges.” The recitation that the “joined areas” extend “*at least* about the[] peripheral edges” of the facing surfaces simply means that joined areas can also occur *away from* the peripheral edges; see, e.g., FIG. 1 of the present application, showing the device being bounded by joined seams about its peripheral edges, but also showing joined seams *within* the peripheral areas:



While the Office Action characterizes this as “indefinite language,” there is nothing indefinite about it: the language is perfectly clear when literally read. Rather, the language is broad – but as noted in MPEP 2173.04, breadth does not amount to indefiniteness.

Regarding claims 13 and 19, these relate to arrangements such as that shown in FIG. 2 and explained at (for example) page 3 lines 30-31 and page 4 lines 7-9, wherein the bladder is affixed to the outer sheet (6) and not the inner sheet (5):



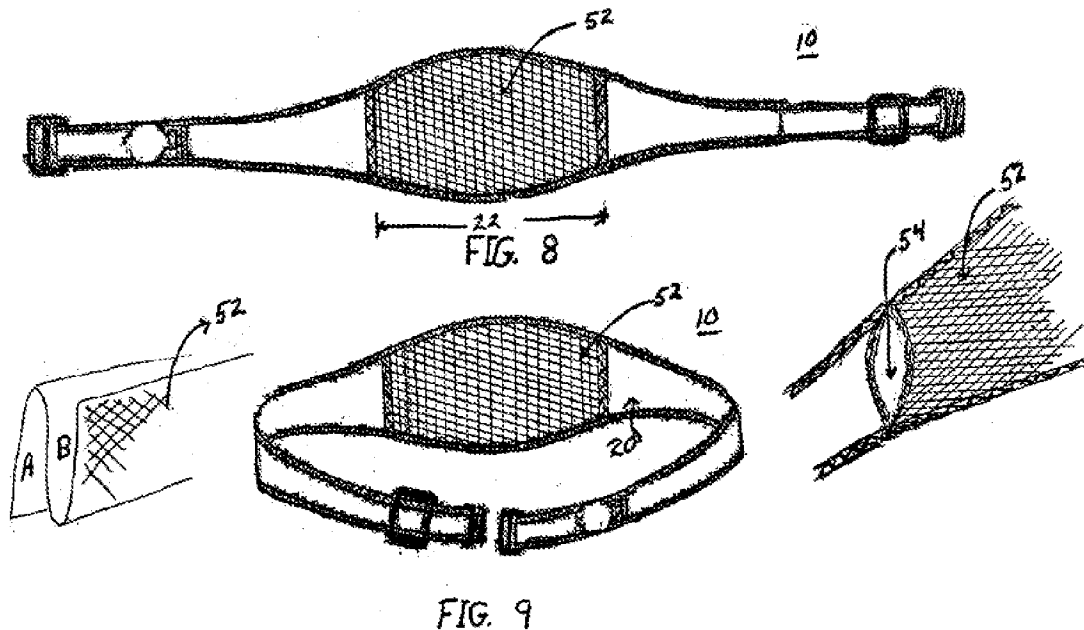
It is not reasonable for the Office to interpret the term “affixed” in such a manner that the bladder is regarded as being “affixed to the inner sheet of the device” during use. The claimed arrangement is analogous to having a button sewn or otherwise affixed to the inner side of one’s pants pocket: no one would consider such a button as being “affixed” to the outer pocket side. In similar respects, an ordinary artisan who reviews the claims in light of the specification would fully understand the scope of claims 13 and 19, and would not regard the bladder as being “affixed” (or “joined”) to the inner sheet in any event.

3. Sections 4-5 of the Office Action: Rejection of Claims 25-29 under 35 USC §101

These claims are compliant with §101 as submitted, since the recitation that the “noninflatable portions *may be* fastened together about the circumference of a limb with the inflatable bladder being situated along the circumference of the limb” does not positively claim a limb (and further, even if a limb was claimed, the §101 prohibition against claiming a human being does not extend to a *portion* of a human). In any event, claim 25 has been amended to further clarify that a limb is not claimed.

4. Sections 6-7 of the Office Action: Rejection of Claims 19-23 under 35 USC §102 in view of U.S. Publ'n. 2003/0125650 to Grosso

Kindly review and withdraw the rejection of claim 19, and its dependent claims 20-23. The Office Action reasons that claim 19 reads on FIG. 9 of *Grosso*:



As described at par. [0038] of *Grosso*:

[0038] FIGS. 8 and 9 illustrate an embodiment of the invention wherein mesh material 52 is utilized to form the belt 10, although as previously discussed, other types of fabric, material or rubber material may be substituted for the mesh. The mesh material 52 can be folded and then stitched to create pockets A and B, which can be used, for example, for the insertion of the cushion 16 (not shown) or a hot or cold pack (also not shown). Typically, the cushion 16 would be located on the outer side of the belt 10, in pocket A, and the hot or cold pack would be inserted on the inner side of the belt 10, in pocket B. In that way, the hot/cold pack would directly contact the wearer's lower back in the proper position. Pockets A and B should be large enough to contain cushion 16 and a hot or cold pack, and it is preferred that the pockets extend the length 22 of the cushion, although pocket B could be shorter than that length if desired. An opening 54 may also be provided towards an end of the folded mesh material 52, for easy insertion of the hot/cold pack. Opening 54 could simply be an unstitched end of folded mesh material 52, or means for closing the opening 54, such as a zipper or Velcro(TM) could be used.

Regarding clauses b(1) and b(2) of claim 19, it is understood that the Office regards the bladder as being affixed to the outer sheet (16 is inserted into pocket A against the outer sheet, and when worn and fully inflated is then affixed to the outer sheet), and not being affixed to the inner sheet (16 is not affixed to the inner sheet because it is separated by the dividing mesh that separate pockets A and B).

This interpretation of “affixed,” while broad, is unreasonable, and is contrary to common usage and understanding of this term: *Grosso*’s bladder is no more “affixed” to any of the sheets than one’s key’s are affixed to their pants pocket after inserting the keys therein. In any event, claim 19 is further amended to recite “physically joined” rather than “affixed” to further emphasize that an actual physical connection exists between the bladder and outer sheet, rather than a mere insertion arrangement as in *Grosso*. Claim 19 is therefore submitted to be novel in view of *Grosso*, and also unobvious because there is no apparent reason why one of ordinary skill would have contemplated the claimed arrangement after review of *Grosso* and the other art of record. In particular, it is by no means apparent why an ordinary artisan would contemplate joining the bladder to the outer sheet while not also joining it to the inner sheet, in a manner discussed above with respect to FIG. 2 (in Section 2 of this Response). This is particularly true where, as here, common practice in the field is to form the bladder directly between attached inner and outer sheets, such that the bladder walls are defined by the sheets. As noted, e.g., in *Ex parte Whalen*, 89 USPQ2d 1078, 1084 (Bd. Pat. App. & Int. 2008):

[T]he Court [in *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 [82 USPQ2d 1385] (2007)] stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the way the claimed new invention does.” *Id.* “To facilitate review, this analysis should be made explicit.” *Id.*

The KSR Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some “apparent reason to combine the known elements in the fashion claimed.” *Id.* at 1741.

Here, there is simply no apparent reason why an ordinary artisan would in fact consider modifying *Grosso* (or any other art of record) to generate the arrangement recited in claim 19. In particular, why would an ordinary artisan truly consider joining the bladder to the outer sheet, but not the inner one? The arrangement requires extra welds or other joining steps, and adds bulk, with no evident benefit. Unless it can be objectively and credibly explained why one of ordinary skill would truly contemplate the claimed arrangement, it cannot be obvious.

Claims 20-24, dependent from claim 19, are submitted to be allowable for at least the same reason as their parent claim 19. Further, regarding claim 20, it is understood that the Office contends:

Regarding claim 20, *Grosso* discloses that at least a substantial portion of the inner sheet defines a heating element (the heating element is disposed within pocket B and therefore would heat the entire inner sheet, Page 4, ¶38).

As this statement admits, the inner sheet of *Grosso* is not a heating element – rather, *Grosso* inserts a heating element adjacent *Grosso*'s inner sheet, with *Grosso*'s inner sheet then being heated rather than performing any heating.

5. Sections 8-10 of the Office Action: Rejection of Claims 25-28 under 35 USC §103(a) in view of U.S. Publ'n. 2003/0125650 to *Grosso*

Claim 25 is submitted to be allowable for much the same reasons as claim 19, discussed above: an ordinary artisan who knew of *Grosso* and the other art of record, but who did not know of Applicant's claimed arrangement, would not in fact conceive or consider the claimed arrangement. As explained in MPEP 2142, for a claimed invention to be obvious, it must be such that it would be contemplated by an ordinary artisan who had no knowledge of the claimed invention:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

If this process is followed, with the claimed invention being placed out of mind and the prior art being objectively considered from the standpoint of an ordinary artisan, it cannot fairly be said that the ordinary artisan would contemplate or consider the claimed invention. If the Office believes otherwise, kindly explain why this is so (as required by *Ex parte Whalen*, discussed in the foregoing Section 4 of this Response).

Claims 27-28 are submitted to be allowable for at least the same reasons as their parent claim 25, and also because *Grosso* does not include electrically conductive material on the inner sheet.

6. Section 11 of the Office Action: Rejection of Claims 11-15, 24, and 29 under 35 USC §103(a) in view of U.S. Publ'n. 2003/0125650 to *Grosso* and U.S. Publ'n. 2003/0191420 to *Kuiper et al.*

Independent claim 11 (and its dependent claims 12-15) are submitted to be allowable for much the same reasons as those discussed in the foregoing Sections 4-5 of this Response, *inter alia*, the

claimed arrangement simply wouldn't come to the mind of an ordinary artisan having no knowledge of the claimed invention, but having full knowledge of *Grosso*, *Kuiper*, and all other art of record. Rather, an ordinary artisan would simply form the bladder directly between the inner and outer sheets, with the inner and outer sheets effectively forming the bladder walls; or would join the bladder to both the inner and outer sheets. The arrangement of claim 12 also differentiates from such arrangements.

7. New Claims 30-31

New claims 30-31 are submitted to be allowable for at least the same reasons as their parent claims, and also because there is no apparent reason why an artisan would consider the claimed arrangement, wherein at least a portion of the borders of the bladder is spaced from the joined areas between the inner and outer sheets. The conventional arrangement in the field is to form a bladder directly between the sheets, such that the borders of the bladder are defined by joined areas between the inner and outer sheets.

8. In Closing

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,



Craig A. Fieschko, Reg. No. 39,668
CUSTOMER NO. 25005
DEWITT ROSS & STEVENS S.C.
2 E. Mifflin St., Suite 600
Madison, WI 53703-2865
Telephone: (608) 395-6722
Facsimile: (608) 252-9243
cf@dewittross.com